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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jeffrey C. Felt et al.



Attorney Docket: 32355.12.1.3.2

Serial No.: 10/722,019

Group Art Unit: 3732

Filed: 24 November 2003

For: METHOD AND SYSTEM FOR  
MAMMALIAN JOINT  
RESURFACING

To: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being:

- deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450  
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on this 15<sup>th</sup> day of February, 2005

By Diane Sisonen

RESPONSE TO RESTRICTION REQUIREMENT

SIR:

This Response is filed in connection with the Office Action mailed November 2, 2004, the period for response which has been extended to February 2, 2005 by the accompanied Petition for Extension of Time.

The Action requires election as between species I though XIV, corresponding to the embodiments set forth in the identified figures.

Applicant elects Species I (corresponding to Figures 1a-1b), with traverse. In turn, it would appear that independent claim 1 is readable on the elected species, and that independent claim 1 is generic as well, in that it would read on both the elected and non-elected species.

MPEP 802.02 clearly provides that an election of species requirement is merely a type of restriction requirement. As such, the present Office Actions fails to meet *either* of the two

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fundamental requirements of *any* restriction requirement, as set forth in MPEP 808, namely, that it provide: (1) reasons why the inventions *as claimed* are either independent or distinct, *and* (2) reasons for insisting on restriction therebetween. Accordingly, the election of species requirement fails to meet the Office's own standards and should be withdrawn. Moreover, the rules (37 CFR 1.141) provide that a reasonable number of species may be included in a single application, where, as here, other conditions are met.

In the interest of facilitating the prosecution of this application, the Examiner is encouraged to telephone the undersigned in order to discuss the matter, and if need be, to attend to whatever further requirements might remain.

The Commissioner is hereby authorized to charge any additional filing fees required to Deposit Account No. 061910. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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